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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,247	09/26/2003	Kohji Kanbara	243108US2	8580

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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04/05/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/670,247	Applicant(s) KANBARA, KOHJI	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 2 of each claim 16 and 22, "within the image forming apparatus" is indefinite because said apparatus is not disclosed clearly enough to understand the boundaries of "within". The claimed apparatus is specifically disclosed only at the first sentence in para. [0072] of the published application (US 20040117258A1).

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-27 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US006615183B1) in view of Short (US006462839B1).

6. Kolls teaches (independent claims 16, 22, 34, 35 and 36, and dependent claims 17 and 23) an image forming and information processing apparatus, and a banner advertisement method, the image forming apparatus (as represented by claim 16) comprising:

a communications mechanism, within the image forming apparatus (*browser software* within an *electronic commerce terminal*, col. 49 lines 31-33, using *modem 544*, col. 25 lines 22-29, where said *terminal* controls *vending equipment* including *copiers*, col. 3 lines 29-49), configured to communicate with a banner advertiser terminal (also the *universal server*, col. 23 lines 8-9) via a network (*network 600*, col. 23 lines 8-9 and col. 13 lines 24-25);

a banner advertisement storage unit (*a database*, col. 33 lines 44-52) configured to store at least two banner advertisements from the banner advertiser terminal (*universal server*);

a displaying mechanism (*a system 500*, col. 23 lines 9-12, with *display means 580* or **582** (col. 15 lines 1-3 and 21-23 and col. 7 lines 6-60 including Figs. 3B-3D, and col. 4 lines 13-14) configured to display a banner advertisement (col. 33 lines 63-65), stored in the banner advertisement storage unit (*a database*, col. 33 lines 44-52), offering at least one of a product and services (col. 6 lines 11-18); and

a response sending mechanism (*LAN network connection means 556*, col. 15 lines 3-19) configured to send to the banner advertiser terminal, through the communications mechanism, at least one of an order and an inquiry for the at least one of the product and the services offered by the banner advertisement displayed on the displaying mechanism.

7. Kolls does not teach that said displaying mechanism is configured to display on a single body of the image forming apparatus that houses image forming mechanisms including copying and printing mechanisms. Short teaches a displaying mechanism that is configured to display on a single body of an image forming apparatus that houses image forming mechanisms including scanning (which reads on copying) and printing mechanisms (col. 2 lines 51-52 and 61-62. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the addition of Short's teaching to those of Kolls would be obvious because prior art elements are being combined according to known methods to yield predictable results. Kolls teaches every feature of the claims placing all the components into or on a single body. Short teaches that this is "conventional". It is obvious to follows convention.

8. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
9. The instant application contains no such clear definition for any of its claim terms, including ad “registration” (claims 20 and 26). The examiner interprets ad “registration” to mean “enrollment”, establishing the ad in the server for delivery. This is inherent since Kolls teaches delivery of the ads from the server (*universal server*, col. 13 lines 19-25) to the displaying mechanism, so they must have been “registered” with the server.
10. The claims are limited to various “mechanisms”. While the term is generally broad (Google definitions), in context one of ordinary skill in the art would understand these mechanisms to be devices, which is to say machines or parts of machines.
11. For claims 17, 23, 34, 35 and 36, Kolls also teaches displaying when the image forming apparatus is in a “non-operative” state (col. 34 lines 39-41).
12. Kolls also teaches claims 18 and 24 (col. 44 lines 45, where “email” is interpreted as any electronic text communication), claim 19 and 25 (col. 17 lines 50-55, where *transaction receipt* reads on an order return message) and claims 21 and 27 (col. 12 line 49).
13. Claims 16-27 and 34-36 are **provisionally** rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US006615183B1). **This rejection** would constitutes a new basis of rejection if imposed herein and therefor **is not being imposed in this Office action**. This rejection is being made or record for the benefit of the BPAI in the event applicant chooses to appeal, and to advise applicant of the full strength of the case against allowance of the instant claims.

14. Kolls teaches (independent claims 16, 22, 34, 35 and 36, and dependent claims 17 and 23) an image forming and information processing apparatus, and a banner advertisement method, the image forming apparatus (as represented by claim 16) comprising:

a communications mechanism, within the image forming apparatus (*browser software* within an *electronic commerce terminal*, col. 49 lines 31-33, using *modem 544*, col. 25 lines 22-29, where said *terminal* controls *vending equipment* including *copiers*, col. 3 lines 29-49), configured to communicate with a banner advertiser terminal (also the *universal server*, col. 23 lines 8-9) via a network (*network 600*, col. 23 lines 8-9 and col. 13 lines 24-25);

a banner advertisement storage unit (*a database*, col. 33 lines 44-52) configured to store at least two banner advertisements from the banner advertiser terminal (*universal server*);

a displaying mechanism (*a system 500*, col. 23 lines 9-12, with *display means 580* or **582** (col. 15 lines 1-3 and 21-23 and col. 7 lines 6-60 including Figs. 3B-3D, and col. 4 lines 13-14) configured to display, within the image forming apparatus (col. 48 lines 59-63), a banner advertisement (col. 33 lines 63-65), stored in the banner advertisement storage unit (*a database*, col. 33 lines 44-52), offering at least one of a product and services (col. 6 lines 11-18); and

a response sending mechanism (*LAN network connection means 556*, col. 15 lines 3-19) configured to send to the banner advertiser terminal, through the communications mechanism, at least one of an order and an inquiry for the at least one of the product and the services offered by the banner advertisement displayed on the displaying mechanism.

15. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not

include ...". An example does not constitute a "clear definition" beyond the scope of the example.

16. The instant application contains no such clear definition for any of its claim terms, including ad "registration" (claims 20 and 26). The examiner interprets ad "registration" to mean "enrollment", establishing the ad in the server for delivery. This is inherent since Kolls teaches delivery of the ads from the server (*universal server*, col. 13 lines 19-25) to the displaying mechanism, so they must have been "registered" with the server.
17. The claims are limited to various "mechanisms". While the term is generally broad (Google definitions), in context one of ordinary skill in the art would understand these mechanisms to be devices, which is to say machines or parts of machines.
18. For claims 17, 23, 34, 35 and 36, Kolls also teaches displaying when the image forming apparatus is in a "non-operative" state (col. 34 lines 39-41).
19. Kolls also teaches claims 18 and 24 (col. 44 lines 45, where "email" is interpreted as any electronic text communication), claim 19 and 25 (col. 17 lines 50-55, where *transaction receipt* reads on an order return message) and claims 21 and 27 (col. 12 line 49).

Response to Arguments

20. Applicant's arguments have been fully considered in the revised rejection, para. 5-12 above. Note in particular the new citations to claims 1 and 4 in Kolls (col. 48 lines 45-63 and col. 49 lines 31-33). The examiner interprets this material as teaching a fully integrated system, fully reading on all the claims. Accordingly, a new **provisional** rejection under 35 USC 102(e) has been added for the applicant's information (para. 13-19 above)..

Search for Allowable Matter

21. The examiner has searched this application for potentially allowable matter (i.e., a feature of the disclosed invention that would overcome the rejection of record) and regret to report that none was found. Kolls has been applied against the claims four times, and the examiner believes Kolls still anticipates the claims, much as it did in the first rejection (mailed 14 January 2008).

22. The examiner particularly considered the “maintenance” feature disclosed in Figs. 3 and 4. However, the examiner could not find a disclosure that distinguishes this functionally or structurally distinguishes this feature over the prior art. The application does disclose a “maintenance company”, but that is an institutional distinction, which is patentably non-functional and non-structural, so it cannot impart patentability. If applicant believes any one or more disclosed features are potentially patentable, it would behoove the applicant to clearly identify those features by an after-final filing under 37 CFR 1.116.

Conclusion

23. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Todome (US pat. 5,070,467) teaches an integrated system, including a fax mechanism (*combination equipment 20*) in one body (*cabinet 28*, col. 3 lines 59 to col. 4 line 8, and col. 4 lines 12-27 and 51-55).
24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
27. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
29. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence in an interview request (form PTOL-413A) that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
30. Applicant may have after final arguments considered and amendments entered by filing an RCE.
31. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

29 March 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688